

REMARKS*1. Claims 1, 7-9, 22-26, and 37*

Claims 1, 7-9, 22-26, and 37 were rejected under 35 U.S.C. § 103 as being obvious in light of the combination of U.S. Patent No. 6,697,620 ("Lamb et al.") and published U.S. Patent Application No. 2005/0059400 ("Jagadeesan").

Claims 1 and 37 have been amended herein to recite that the roaming-agreement information includes a routing protocol, and further to recite the step of determining, based on the routing protocol, whether to route communications with the mobile subscriber terminal over the public-wireless network or over a transport network.

These amendments could not have been presented earlier because the Jagadeesan reference over which they distinguish were first brought to the Applicant's attention in the Final Office Action of March 13, 2006. The use of the routing protocol is described in, for example section 4.D of the specification, at pages 24-29 and Fig. 5.

Neither Lamb et al. nor Jagadeesan, nor any other references of record, describe a method in which (1) a mobile subscriber terminal registers on a private wireless local area network, (2) a public wireless network to which the mobile subscriber terminal subscribes is identified, (3) wherein the public wireless network and the private wireless local area network use different communications formats for communications with the mobile subscriber terminal, (4) roaming-agreement information is retrieved from a roaming-agreement database, wherein the roaming-agreement information includes a routing protocol, (5) a determination is made, based on the routing protocol, whether to route communications with the mobile subscriber terminal over the public-wireless

network or a transport network; and (6) communications services are provided to the mobile-subscriber terminal in accordance with the roaming-agreement information.

In particular, the references of record do not describe a system in which roaming-agreement information is used to determine whether communications are routed through the public wireless network or a different transport network. For example, although U.S. Patent No. 6,539,237 ("Sayers '237") does show a private wireless network that is connected to the Internet, it does not disclose or suggest that a decision of whether to route communications from a mobile-subscriber terminal to a transport network or to the private wireless network may be based on information in a roaming-agreement database.

Thus, neither Lamb et al. nor Jagadeesan discloses or suggests a method as recited in claim 1 as amended. None of the remaining prior art of record discloses or suggests a method as recited in claim 1, and claim 1 is believed to be patentable over the prior art.

2. Claims 2, 3 and 27-32

Claims 2, 3 and 27-32 were rejected under 35 U.S.C. § 103 as being obvious in light of the combination of U.S. Patent No. 6,697,620 ("Lamb et al.") and published U.S. Patent Application No. 2005/0059400 ("Jagadeesan") and further in view of published U.S. Patent Application No. 2002/0061766 ("Sato et al.").

Claims 2, 3, and 27-32 depend from and further limit claim 1. As a result, these claims are believed to be patentable for the reasons described above with respect to claim 1.

3. Claims 4-6

Claims 4-6 were rejected under 35 U.S.C. § 103 as being obvious in light of the combination of U.S. Patent No. 6,697,620 ("Lamb et al.") and published U.S. Patent Application No. 2005/0059400 ("Jagadeesan") and further in view of published U.S. Patent Application Nos. 2002/0061766 ("Sato et al.") and 2001/00468660 ("Lee").

Claims 4-6 depend from and further limit claim 1. As a result, these claims are believed to be patentable for the reasons described above with respect to claim 1.

4. Claims 10-11 and 15-20

Claims 10-11 and 15-20 were rejected under 35 U.S.C. § 103 as being obvious in light of the combination of U.S. Patent No. 6,697,620 ("Lamb et al."), published U.S. Patent Application No. 2005/0059400 ("Jagadeesan"), and 6,687,243 ("Sayers '243").

Claim 10 has been amended to remove subject matter that, in light of the amendments to claim 1, could otherwise appear redundant. Claims 10-11 and 15-20 depend from and further limit claim 1. As a result, these claims are believed to be patentable for the reasons described above with respect to claim 1.

5. Claims 12-14 and 21

Claims 12-14 and 21 were rejected under 35 U.S.C. § 103 as being obvious in light of the combination of U.S. Patent No. 6,697,620 ("Lamb et al."), published U.S. Patent Application No. 2005/0059400 ("Jagadeesan"), and 6,687,243 ("Sayers '243") and further in view of published U.S. Patent Application No. 2002/0061766 ("Sato et al.").

Claims 12-14 and 21 depend from and further limit claim 1. As a result, these claims are believed to be patentable for the reasons described above with respect to claim 1.

6. Claims 15-20

Claims 15-20 were further rejected under 35 U.S.C. § 103 as being obvious in light of the combination of U.S. Patent No. 6,697,620 ("Lamb et al."), published U.S. Patent Application No. 2005/0059400 ("Jagadeesan"), U.S. Patent No. 6,687,243 ("Sayers '243"), and U.S. Patent No. 6,539,237 ("Sayers '237").

Claims 15-20 depend from and further limit claim 1. As a result, these claims are believed to be patentable for the reasons described above with respect to claim 1.

7. Claim 33

Claim 33 was rejected under 35 U.S.C. § 103 as being obvious in light of the combination of U.S. Patent No. 6,697,620 ("Lamb et al."), published U.S. Patent Application No. 2005/0059400 ("Jagadeesan"), U.S. Patent No. 6,539,237 ("Sayers '237") and further in view of published U.S. Patent Application Nos. 2002/0061766 ("Sato et al.") and 2004/0203890 ("Karaoguz et al.").

The applicant maintains that there is no motivation in the prior art to combine Karaoguz et al. with the remaining cited references. As the Examiner argues, "Both

references are concerned with providing services.” (Page 2.) This is true, but it is not sufficient to provide the required teaching or motivation to combine references. Indeed, following the recited grounds for the rejection, *any* two references relating to the telecommunications field could be combined to reject practically any novel combination of elements.

Because there is no motivation in the art to combine the disclosure of Karaoguz et al. with the other cited references, claim 33 is believed to be patentable over the cited art. Moreover, Claim 33 depends from and further limits claim 1. As a result, this claim is further believed to be patentable for the reasons described above with respect to claim 1.

8. Claims 34 and 35

Claims 34 and 35 were rejected under 35 U.S.C. § 103 as being obvious in light of the combination of U.S. Patent No. 6,697,620 (“Lamb et al.”), published U.S. Patent Application No. 2005/0059400 (“Jagadeesan”), and further in view of published U.S. Patent Application No. 2004/0242208 (“Teicher”).

Claims 34 and 35 depend from and further limit claim 1. As a result, these claims are believed to be patentable for the reasons described above with respect to claim 1.

9. Claim 36

Claim 36 was rejected under 35 U.S.C. § 103 as being obvious in light of the combination of U.S. Patent No. 6,697,620 (“Lamb et al.”) and published U.S. Patent Application No. 2005/0059400 (“Jagadeesan”), and further in view of published U.S.

Patent Application Nos. 2004/0242208 ("Teicher") and 2003/0100303 ("Armbruster et al.").

Claim 36 depends from and further limits claim 1. As a result, this claim is believed to be patentable for the reasons described above with respect to claim 1.

10. Conclusion

Now pending in this application are claims 1-37. Claims 1 and 37 are independent. For the foregoing reasons, the Applicant submits that all of the pending claims are now in condition for allowance, and thus the Applicant respectfully requests notice to that effect.

Should the Examiner wish to discuss any aspect of this application, the Examiner is welcome to call the undersigned at (312) 913-2115.

Respectfully submitted,

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